Remarks

1.   Introduction

In the office action dated September 10, 2004, the Examiner rejected all pending claims. The Examiner rejected claims 4 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Harvey *et al.*, U.S. Patent No. 6,487,583 ("Harvey"). Additionally, the Examiner rejected claims 5, 12, and 16 under 35 U.S.C. § 103(a) as being obvious over a combination of Harvey and Lim *et al.*, U.S. Patent No. 6,574,599 ("Lim"). As shown above, the Applicant has amended claims 12 and 15, in accordance with the results of the September 2, 2004 interview with the Examiner. (*See Interview Summary*, September 29, 2004). No new matter has been added by any of the amendments. Now pending are claims 4-8, 12, and 15, of which claims 4, 12, and 15 are independent and the remainder are dependent. Applicants respectfully request reconsideration of the claims, as amended, for the following reasons.

2.   Reply to the Examiner's Response to Arguments

In the most recent Office Action, the Examiner rejected Applicant's earlier arguments and thus all of Applicant's pending claims. Applicant respectfully traverses these rejections because there is no suggestion or motivation in Harvey to modify it in the manner suggested by the Examiner. In particular, as the following arguments explain in greater detail, the Applicant disagrees with the Examiner's characterization of (a) what the Applicant has claimed, (b) the nature of the Harvey community, and consequently (c) the differences between the Harvey community (and thus any community *suggested* by Harvey) and each of the Applicant's second Personal Address Books (PABs).

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a.   The Applicant's claims

The Examiner inaccurately stated that the Applicant's claim 4 "requires creating *an* address book for the *users* who provided an acceptance for [the] invitation." (September 10, 2004 Office Action, page 2, paragraph 2, emphasis added). To the contrary; all of Applicant's claims recite creating a second Personal Address Book respectively for *each* user or caller who provided an acceptance. For example, claim 4 recites "...in response to receiving *each* of said acceptances, creating *a* second Personal Address Book for *the* user who provided the acceptance." (Emphasis added). Similarly, currently amended claims 12 and 15 each recite "...wherein one second Personal Address Book is created respectively *for each invited caller* who provided an acceptance." (Emphasis added).

b.   Applicant's understanding of the nature of Harvey's community

The Applicant also respectfully submits that it is incorrect to conclude from Harvey's specification that "a new community is created for those who accept the invitation." (September 10, 2004 Office Action, page 2, paragraph 2). That statement implies that a community is created in response to acceptances by invited users. To the contrary: to the best of Applicant's understanding, no new community is created when Harvey's invited users accept their invitations. Instead, Harvey's invited users all join the same community to which they were invited – a community that existed before they joined.

i.   *No new community is created in response to Harvey's acceptances.*

In Harvey, upon accepting their invitations, (1) multiple users join the same community, and (2) that community exists before, rather than being created in response to, any user's acceptance of an invitation. First, as Harvey explains, upon creating the community, "the creator designates other *users* to access *the* community" by selecting the names and email addresses of

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those to be invited to the community. (Harvey, col. 4, lines 44-51, emphasis added). Thus multiple users are joined in one community. Although the *nature* of the community may change with the acceptance and addition of each new invited user, it remains the same community that existed before any invited user accepted an invitation to join it, with the same "look and feel," "artwork and fonts," and other parameters as the creator initially created. (Harvey, col. 7, lines 33-37). Hence Harvey's invention can "enable multiple users to connect within a specific community" (Harvey, Abstract), and an invited user can later "exit" the community (Harvey, col. 9, lines 26-30, and col. 17, lines 22-23). If Harvey's invention instead created a new separate community for each invited user who accepted an invitation, such connections would not be possible, and it would be nonsensical to explain that the invited user could "exit" his own community.

Second, Harvey's community pre-exists any invited user's acceptance. (*See, e.g.,* Harvey, col. 7, lines 24-44). Thus the creator of Harvey's community "may invite people to join" the community (Harvey, col. 12, lines 51-52; *see also* col.. 4, line 56). It would be impossible for Harvey's users to be invited to join a community that did not already exist before they accepted their invitation. Furthermore, each of Harvey's communities may have "one or more groups associated with the community," where each of these groups is created to comprise a *set* of invited users, and is created *prior* to sending any invitations or receiving any acceptances. (Harvey, col. 11, lines 12-27). Yet these groups are not created in response to an acceptance. Instead, it is the *creator* who sets up these groups by creating multiple "mailing lists" at step 224, prior to inviting any users to the community at step 228. (Harvey, col. 7, lines 43-48, col. 11, lines 14-27, and col. 12, lines 51-54). Again, although the *nature* of the group

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may change if an invited user joins or exits the group, the group exists *prior* to any invited user's acceptance.

Thus, Harvey's invention does not *create* a new community in response to a single acceptance, much less does it create a new community in response to all of the invited users who accept an invitation. Indeed, the community that the invited user enters upon his or her acceptance already exists before the invited user accepts the invitation.

ii. Harvey's use of the term "new community" must be put into context.

The Applicant respectfully suggests that the Examiner's view concerning the nature of Harvey's community may have its source in the manner in which Harvey uses the term "new community." In particular, Harvey describes a "*new community* to which the invited users is to be invited." (Harvey, col. 15, lines 13-14, emphasis added). Taken out of context, this "new community" might appear similar to Applicant's "second Personal Address Book" created for the invited user who provided the acceptance. Yet a closer reading of Harvey demonstrates that Harvey uses the term "new" to distinguish between an initial community that the invited user has already joined, and a different ("new") community that the invited user is currently joining.

Harvey is merely stating that if an invited user is part of one community created by one inviting user, the same invited user can join yet another community (the "new" community) created by the same or a different inviting user. As Harvey explains, "an invited user may already be registered with another community and have previously received an executable component." (Harvey, col. 15, lines 9-11; *see also* col. 14, lines 21-22). Harvey then uses the term "new community" simply to explain that one invited user may be invited to more than one of Harvey's communities. (Harvey, col. 15, lines 11-16).

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c.   Harvey's communities differ from and do not suggest Applicant's PABs.

Harvey's communities neither describe nor suggest Applicant's second Personal Address Books (PABs), for several reasons. First, Applicant's second Personal Address Books are *"personal"* to the invited user or caller, whereas Harvey's communities are not. Second, each of Applicant's second Personal Address Books is created *in response to an acceptance* by an invited user or caller, while Harvey's communities, groups, address books and Pal's lists are not. Third, each of Applicant's second Personal Address Books are created respectively *"for" the user or caller who provided the acceptance,* while Harvey's communities and address books belong to the inviting user or creator, not the invited user. Finally, in contrast to Applicant's second PABs, each of which is created for a single invited user or caller *after that party has accepted* an invitation, each of Harvey's communities *pre-exists* the invited users' acceptances to join that community (as explained above). These points of distinction are discussed further in the following paragraphs.

First, while each of Applicant's second Personal Address Books is personal to a particular invited user, in Harvey's invention, a group of users all belong to the same community. This fact is demonstrated in that, for example, Harvey's invited users join "the" community (Harvey, col. 4, lines 56-57) or "a" community (Harvey, col. 12, line 51). If instead Harvey's invention were to create a new community for each new invited user, Harvey would not describe "the" new community as a single community to which the multiple invited "users" are to be invited (Harvey, col. 15, lines 13-14), nor would Harvey describe how the central controller module may record invited "users" who declined an invitation to "a" single community (Harvey, col. 15, lines 61-64). Harvey's claims contemplate methods and systems for "enabling users to interact within a community" or for "interacting with a community of interest," further pointing

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away from a "personal" community. *See, e.g.,* claims 1, 14, 29 and 39. Even where Harvey in his claims allows for the possibility of only one user accepting an invitation (*see, e.g.,* claim 1), the community is not personal to that user, because the inviting user is already a part of the community. In contrast, each of Applicant's invited users or callers who have accepted an invitation is granted a second Personal Address Book that is, by its very description, "personal" to that particular invited user or caller.

Second, none of Harvey's communities, groups, communication address books (Harvey, col. 4, lines 45-49) or Pals lists (Harvey, col. 17, lines 27-42) is created *in response to an acceptance by an invited user.* Instead, each of Harvey's communities, groups, address books, and Pals lists is created by a creator/inviting user, who subsequently invites invited users to the community. Although Harvey does suggest that the inviting user can add users to the Pals list, the inviting user must do so manually (*e.g.,* "by highlighting *a user* within a chat room users list and adding [it] to a pals list button"; *see* Harvey, col. 17, lines 27-42). Thus the "pals" are already participants in the community (indeed they are already listed in the "chat room users list") before they are added to the Pals list. Further, Harvey does not indicate that that pals' list is a list of addresses. It may simply be a list of names. In fact, Harvey distinguishes the "pals application object" from the "e-mail list application object" (*see, e.g.,* Harvey, claim 3), and further provides that a client application must read a communication address book *in addition* to a pals list in order to compile names and addresses into a list. (Harvey, col. 17, lines 36-41). Furthermore, although a user "may be added to the [pals] list by default," that user is not added to the list upon that user's acceptance of an invitation, but instead is added to the list because that user has invited another user into the community. (Harvey, col. 17, lines 31-32). Indeed, that

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user need only invite another user to the community; there is no suggestion that the invited user even accept the offer to join.

Third, Harvey's community address books and community parameters are created by and are, at least at their creation, personal to the *inviting user* (the creator), not the invited user (Harvey, col. 17, lines 18-20), whereas each of Applicant's second Personal Address Books is created for the user or caller who provided the acceptance, as claimed. In fact, Harvey's address book is described as the "creator's... communications address book" (*see, e.g.,* Harvey, col. 12, lines 60-63) or the "[inviting] user's communication address book" (*see, e.g.,* Harvey, col. 13, lines 5-10). Furthermore, although in Harvey "a creator may indicate that all members of a community must disclose the user's actual name and address in a profile," (Harvey, col. 12, lines 38-50), the decision to require this disclosure belongs to *the inviting user*. Similarly, while an invited user may automatically receive updated content from Harvey's new community (September 10, 2004 Office Action, p. 3, lines 7-8, and p. 5, lines 16-17; Harvey col. 16, lines 29-39), the choice of *which* information will be updated is at the discretion of the inviting user. Indeed, this act further points away from the community being at all "personal" to and created "for" a single invited user. In contrast, in Applicant's invention, a second *Personal* Address Book is created *for each invited user* (or caller) who accepts the invitation. (*See, e.g.,* claim 4: "...in response to receiving *each* of said acceptances, creating a second Personal Address Book *for the user who provided the acceptance*").

Thus, each of Applicant's second Personal Address Books is (1) personal to a single invited user or caller, (2) created in response to that party's acceptance, (3) created expressly "for" that specific party, and (4) created only *after* that party has accepted the invitation. In

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contrast, none of Harvey's communities fulfills or even suggests these four qualifications. Consequently Harvey points away from, and not toward, Applicant's invention.

3. Response to Claim Rejections

a. Claims 4-8

The Examiner rejected claims 4 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Harvey. Applicant respectfully traverses these rejections because there is no suggestion or motivation in Harvey to modify Harvey in the manner suggested by the Examiner, and as required by M.P.E.P. § 2143.

Contrary to the Examiner's suggestion, Harvey does not disclose or suggest "creating [a] new community by generating an invitation message to other users and inviting them to join the community." (September 10, 2004 Office Action, page 5, lines 1-4). Instead, Harvey's community exists before the invitation message is even generated, as discussed above.

Furthermore, while Harvey's user does select a list of people to invite to the community, it is incorrect to suggest that this list (which the Examiner called a "second address list"; *see* September 10, 2004 Office Action, page 5, line 9) is in any way analogous to one of Applicant's second Personal Address Books. As explained above, this second address list is not created in response to an invited user's acceptance, nor is it created as a personal list for the user who provided the acceptance. Instead, Harvey's newly created list is merely the result of picking names and addresses from a communication address book and a pals list, and then storing them together in a new list. (Harvey, col. 17, lines 36-41). The newly created list may be, at best, analogous to the claimed "first Personal Address Book containing a plurality of entries, each of said entries having associated connection information and an associated user." But, it still does not equate to receiving acceptances from the associated users and, in response to receiving each

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of said acceptances, creating a second Personal Address Book for the user who provided the acceptance, as claimed. Instead, as the Examiner previously stated, Harvey is "silent regarding creating a second personal address book." (February 27, 2004 Office Action, p. 3, at lines 16-17; *see also* September 10, 2004 Office Action, p. 4, at line 24-page 5, line 1).

The Examiner further suggested that Harvey's address book is "easily accessible to its owners" and emphasizes that an invited user may automatically receive updated content from Harvey's new community (September 10, 2004 Office Action, p. 3, lines 7-8, and p. 5, lines 16-17). However, the choice of *which* information will be updated is at the discretion of the inviting user. Furthermore, even if the list were to be made available to all of the invited users, the list still would not be personal to a single invited user, and still would not be created for that user and in response to that user's acceptance.

Consequently, Harvey contains no suggestion or motivation to create a second Personal Address book "for the user who provided the acceptance," as claimed. There is no suggestion in the sections referenced by the Examiner or anywhere else in Harvey to create a second Personal Address Book for an invited user who accepted an invitation, in response to that acceptance. Indeed, the only reason to modify Harvey in this way is the Applicant's invention. However, it is impermissible to use the Applicant's claims as a blueprint for hindsight reconstruction. Consequently, Harvey does not provide or suggest all of the elements of claim 4, and the Applicant submits that a *prima facie* case of obviousness of claim 4 does not exist.

Therefore, for the reasons stated above, claim 4 is patentable over Harvey. Claims 5-8 depend from claim 4, therefore, the Applicant submits that claims 5-8 are also patentable over Harvey.

b.   **Claims 5, 12 and 15**

The Examiner rejected claims 5, 12 and 15 under 35 U.S.C. § 103(a) as being obvious over a combination of Harvey and Lim. Applicant respectfully traverses this rejection because the combination of Harvey and Lim does not disclose or suggest the combination of elements in any of claims 5, 12 or 15. Under M.P.E.P. § 2143, in order to establish a *prima facie* case of obviousness of a claimed invention by applying a combination of references, the proposed combination must teach or suggest all of the elements of the claimed invention. The combination of Harvey and Lim fails to do so.

Neither Harvey nor Lim discloses or suggests all of the limitations of Claim 5, 12, or 15. Not only does Harvey not "show receiving a voice message from a user," as the Examiner aptly noted (September 10, 2004 Office Action, page 6, lines 8-10), Harvey also does not disclose or suggest creating a second Personal Address Book in response to receiving acceptances from those associated users or invited callers who have been invited to subscribe to a subscribing community. Harvey merely claims, but does not describe, a "voice chat application object." (*See, e.g.,* claim 3 *et seq.*). Furthermore, as the Examiner noted, "Lim was solely relied on" for "receiving a voice message from a user, which Harvey did not teach." (September 10, 2004 Office Action, page 3, lines 12-15). Therefore, because neither Harvey nor Lim discloses or suggests creating a second Personal Address Book in response to receiving acceptances from associated users or invited callers who have been invited to subscribe to a subscribing community, the combination of Harvey and Lim fails to teach or suggest all of the elements of any of claims 5, 12, or 15. Consequently, Applicant respectfully submits that a *prima facie* case of obviousness does not exist for claims 5, 12, and 15, and that claims 5, 12 and 15 are patentable over Harvey and Lim.
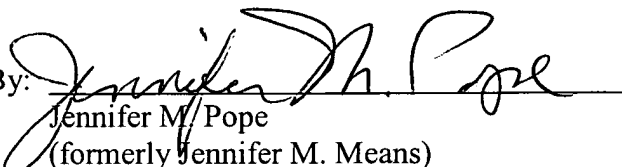
4.   Conclusion

For the reasons set forth above, the Applicant submits that claims 4-8, 12, and 15 are in condition for allowance.   Therefore, Applicant respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

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Dated: November ___8___, 2004

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